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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/666,915  | 09/18/2003  | Rajendra Mehta       | STD 1184 PA/41213.541 | 6466             |
| 23368   | 7590        | 11/14/2006           | EXAMINER              |                  |
| DINSMORE & SHOHL LLP<br>ONE DAYTON CENTRE, ONE SOUTH MAIN STREET<br>SUITE 1300<br>DAYTON, OH 45402-2023 |             |                      | FERGUSON, LAWRENCE D  |                  |
|   |             |                      | ART UNIT              | PAPER NUMBER     |
|   |             |                      | 1774                  |                  |

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/666,915

Applicant(s)

MEHTA ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 50-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 60-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed September 22, 2006.  
Claims 1, 33 and 43 were amended rendering claims 1-63 pending, with claims 50-59 withdrawn as a non-elected invention.

### ***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-7, 9-12, 18-22, 30-32 and 60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Lakes et al. (U.S. 5,912,205).

Lakes discloses a security document to provide an authentication feature and/or an indicated of attempted alterations from the sue of solvents, heat or abrasion, where the security document comprises a substrate having a composition on one of its major surfaces which activates to produce a color upon the application of a solvent, heat or abrasion (column 2, lines 5-15) where the color forming composition may be fully coated on the entire surface of the substrate or spot coated onto one or ~~or~~ more predetermined areas of the substrate and may be printed as covert authentication indicia (column 4,

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lines 49-55). The covert warning indicia printed on the document can have a pattern such as VOID on the surface of the substrate (column 2, lines 39-44 and Figures 2-3). Lakes further discloses one embodiment of the invention is to have authentication indicia on one portion of the document and a covert warning indicia on another portion of the document (column 5, lines 1-6) where the document shows attempted alteration by the use of solvents (column 5, lines 25-29). A toner adhesion composition is applied over the color forming composition, which can be removed through abrasion such as vigorous rubbing (column 5 lines 49-67). Lakes discloses using laser printing and using the security documents for checks and documents of value (column 3, lines 62-67) where the document is printed using flexographic printing (column 5, lines 20-22 and column 7, lines 15-17, 41-44).

***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205).

Lakes is relied upon for instant claim 1. Lakes does not explicitly disclose the percentages of the flexographic ink components. Lakes does not show that the

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flexographic ink has a property percentage as in instant claim 8. However, such percentages are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the property percentages, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. percentage) fails to render claims patentable in the absence of unexpected results. The flexographic printing composition percentages are optimizable as they directly affect the opacity of the document. It would have been obvious to one of ordinary skill in the art to make the security document with the limitations of the flexographic ink percentage properties since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

***Claim Rejections – 35 USC § 103(a)***

6. Claims 15-17 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Taylor et al (U.S. 6,062,604).

Lakes is relied upon for claim 1. Lakes does not disclose folding the document. Taylor teaches a security document comprising optically variable ink (column 1, lines 9-21) formed from a substrate having a coating on one or both sides, where the sheet is flexible and can be folded about a center line, which bring both sides of the folded article together (column 2, lines 22-46). Lakes and Taylor are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have folded

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the security document, as taught in Taylor, in the security document of Lakes so the second portion of the security document can be inspected or verified by viewing both the first and second portions together (column 2, lines 54-64).

***Claim Rejections – 35 USC § 103(a)***

7. Claims 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Berson (U.S. 5,932,870).

Lakes is relied upon for claim 1. Lakes does not disclose a bar code. Berson teaches a security document in the form of a driver's license having a bar code for abrasion resistance. Lakes and Berson are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have included a bar code, as taught in Berson, in the security document of Lakes to improve the security for the documents (column 2, lines 20-27).

***Claim Rejections – 35 USC § 103(a)***

8. Claim 13-15 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Halbrook, Jr. et al. (U.S. 5,883,043).

Lakes is relied upon for claim 1, as above. Lakes does not explicitly disclose optically variable ink such as thermochromic ink. Halbrook, Jr. teaches a security document (column 1, lines 5-10) having optically variable pigments and dyes such as thermochromic (column 3, lines 1-5). Lakes and Halbrook, Jr. are both directed to security documents. It would have been obvious to one of ordinary skill in the art to

have included thermochromic ink, as taught in Halbrook, Jr., in the security document of Lakes to improve the security for the document.

***Claim Rejections – 35 USC § 103(a)***

9. Claims 4-5, 24-29, 33-46 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes et al. (U.S. 5,912,205) in view of Lu (U.S. 5,591,527).

Lakes is relied upon for claim 1, as above. Lakes does not disclose the article is a drivers license. Lu teaches security articles comprising an image or design (column 1, lines 50-55) having a separation layers (column 2, lines 10-25) where the substrate may be made of paper and is a drivers license (column 3, lines 1-5). Lu further teaches the article has a layer to protect the substrate (column 5, lines 17-22) having a laminate comprising two or more layers (column 12, lines 55-60) which are tear resistant. The article can be coated on the back side of the article (column 16, lines 5-11). Lakes and Lu are both directed to security documents. It would have been obvious to one of ordinary skill in the art for the security document to be drivers license, as taught in Lu having the added security features to protect and identify the consumers using the security cards.

***Response to Arguments***

10. Applicant's arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,492) are moot based on grounds of new rejection.

Applicant's arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,492) in view of Taylor et al (U.S. 6,062,604) are moot based on grounds of new rejection.

Applicant's arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Berson (U.S. 5,932,870) are moot based on grounds of new rejection.

Applicant's arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Halbrook, Jr. et al. (U.S. 5,883,043) are moot based on grounds of new rejection.

Applicant's arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Lu (U.S. 5,591,527) are moot based on grounds of new rejection.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-



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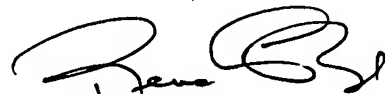
272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

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11/9/04